

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

JUN 27 2003

Ex parte ALLAN LEPINE

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2001-2463
Application No. 09/163,778

ON BRIEF

Before GARRIS, PAWLICKOWSKI and MOORE, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 1 and 3-14. Claim 2 has been canceled. Thus, claims 1 and 3-14 are before us on appeal.

REPRESENTATIVE CLAIMS

Claims 1, 13, and 14 are representative of the claimed subject matter and read as follow:

1. An artificially produced canine milk substitute composition comprising, on a dry matter basis, from about 35 to 45% protein, from about 25 to 35% fat, and from about 10 to 25% carbohydrates; wherein said protein comprises casein and whey in a weight ratio of about 70:30.

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13. An artificially produced canine milk substitute composition comprising, on a dry matter basis, from about 35 to 45% protein, from about 25 to 35% fat, and from about 10 to 25% by weight carbohydrates, said composition further comprising from about 4 to 8% by weight lactose and about 0.50% by weight fructooligosaccharide.

14. An artificially produced canine milk substitute composition comprising, on a dry matter basis, from about 35 to 45% protein, from about 25 to 35% fat, and from about 10 to 25% carbohydrates, wherein the source of fat is selected from the group consisting of corn oil, canola oil, butter oil, arachidonic acid, docosahexaenoic acid, and blends thereof.

The References

In rejecting the claims under 35 U.S.C. § 103(a), the examiner relies upon the following references:

Kinumaki et al. (Kinumaki)	4,294,856	Oct. 13, 1981
Traitler et al. (Traitler)	4,938,984	Jul. 03, 1990
Fujimori	5,294,458	Mar. 15, 1994
Gil et al. (Gil)	5,709,888	Jan. 20, 1998

Oftedal, "Lactation in the Dog: Milk Composition and Intake by Puppies," J. Nutr., 114:803-812 (1984).

We discuss the following additional reference in the body of this opinion:

Meyer EP 0 259 713 B1 Mar. 18, 1992
(European Patent)

We rely upon the following prior art in formulating the new ground of rejection:

Specification, page 1, lines 8-11, discussing naturally occurring canine milk and the known formulation of replacement milk; page 4, line 11 - page 6, line 22, discussing the detailed analysis of naturally occurring canine milk; and page 7, lines 17-22, discussing the known benefits of fructooligosaccharide (Admitted Prior Art).

The Invention

The invention relates to a canine milk substitute which has been formulated to contain amounts of protein, fat and carbohydrates which closely match the concentration of those components in natural canine milk. The composition includes, by weight of dry matter, from about 35 to 45% protein, from about 25 to 35% by weight fat, and from about 10 to 25% by weight carbohydrates. The protein source comprises casein and whey in a weight ratio of about 70:30. The canine milk substitute is said to provide greater daily weight gain and improved growth in puppies when compared to commercially available milk replacers (Appeal Brief, page 2, lines 10-20). Further details of the claimed invention are seen by reference to claims 1, 13 and 14 reproduced above.

Discussion

I. Prefatory Issues

We preliminarily note that the statement of the rejection in the Examiner's Answer is defective. It states "[c]laims 1 and 3-14 [are] rejected under 35 U.S.C. 103. This rejection is set forth in prior Office Action, Paper No. 9." (Examiner's Answer, page 3, lines 13-14). Paper #9, the Final Rejection, applies 5 separate rejections, none of which is equivalent to the summary statement of the rejections in the Examiner's Answer. Further, no

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explanation of the rejection is found there. Instead, a further reference to an unidentified "previous Office Action" is made. (Paper #9, page 2, line 4 - page 3, line 10).

Searching yet further into the prosecution history reveals that the "previous Office Action" must be paper #5, dated December 28, 1999. In that Official Action, each rejection is reiterated "for the reasons stated in the first Office Action" (Paper #5, page 2, lines 14-15) or "for the reasons noted in the first Office Action" (page 3, lines 8-9).

Note MPEP 1.193, which provides in pertinent part:

If there is a complete and thorough development of the issues at the time of final rejection, it is possible to save time in preparing the examiner's answer required by 37 CFR 1.193 by taking any of the following steps:

(A) Examiners may incorporate in the answer their statement of the grounds of rejection merely by reference to the final rejection (or a single other action on which it is based, MPEP § 706.07). Only those statements of grounds of rejection appearing in a single prior action may be incorporated by reference. **An examiner's answer should not refer, either directly or indirectly, to more than one prior Office action.** Statements of grounds of rejection appearing in actions other than the aforementioned single prior action should be quoted in the answer. The page and paragraph of the final action or other single prior action which it is desired to incorporate by reference should be explicitly identified (Emphasis Added).

We believe failure to follow this rule has, at least in part, led to the reversal of the applied rejections as the examiner has

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failed to address claim 1 as amended to incorporate the subject matter of claim 2. However, for the sake of judicial economy and to speed the decisional process we shall address the rejections.

The rejections at issue, having been exhumed from the prosecution history (Paper #3), are as follows:

- A) Claims 1, 3-5 and 9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kakade and Oftedal.¹
- C) Claims 6 and 14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Oftedal in view of Kakade as applied to claims 1, 3-5 and 9, and further in view of Gil.
- D) Claims 7 and 11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kakade, Oftedal, and Gil as applied to claims 6 and 14, further in view of Traitler.
- E) Claims 8 and 12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kakade and Oftedal as applied to claims 1, 3-5 and 9, and further in view of Kinumaki.
- F) Claims 10 and 13 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kakade and Oftedal as applied to claims 1, 3-5 and 9, further in view of Fujimori.

¹ We note that the rejection we have termed "B" indicated that Claim 2 was rejected under 35 U.S.C. §103(a) as being unpatentable over Oftedal and Kakade as applied to claims 1, 3-5 and 9, further in view of Irvine. Claim 2 was canceled and incorporated into claim 1, and this rejection was withdrawn. The reference cited in rejection "B" was not reapplied.

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II. The Claimed Subject Matter

An analysis of the issues necessarily starts with identification of the claimed subject matter, as this determination governs the remainder of the decisional process. We note that all of the appealed claims relate to a composition containing various substituents. The preambles of the appealed independent claims each recite that the composition is "An artificially produced canine milk substitute composition comprising...." (See, e.g. claims 1, 13, and 14.). The claims then go on to recite the actual composition constituents and amounts.

Generally, the preamble does not limit the claims. DeGeorge v. Bernier, 768 F.2d 1318, 1322 n.3, 226 USPQ 758, 764 n.3 (Fed. Cir. 1985). However, the preamble may be limiting "when the claim drafter chooses to use both the preamble and the body to define the subject matter of the claimed invention." Bell Communications Research, Inc. v. Vitalink Communications Corp., 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). If the preamble is "necessary to give life, meaning and vitality" to the claim, then the claim preamble should be construed as limiting. Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 480-81 (CCPA 1951). This is determined "on the facts of each case in view of the claimed invention as a whole." In re Stencel, 828 F.2d 751, 754, 4 USPQ2d

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1071, 1073 (Fed. Cir. 1987); see also Applied Materials, Inc. v. Advanced Semiconductor Materials Am., Inc., 98 F.3d 1563, 1572-73, 40 USPQ2d 1481, 1488 (Fed. Cir. 1996) ("Whether a preamble stating the purpose and context of the invention constitutes a limitation . . . is determined on the facts of each case in light of the overall form of the claim, and the invention as described in the specification and illuminated in the prosecution history.").

In the present instance, the claims are directed to a clearly defined composition, with components and amounts. The preamble adds nothing to the composition other than to state an intended use of the composition. We note that it has been held that a process of use limitation, as recited in the preamble of the claim, has no significance in a product claim. Cf. In re Wiggins, 397 F.2d 356, 359 n.4, 158 USPQ 199, 201-202 n. 4 (CCPA 1968). In Wiggins, the claim was directed to a composition, and the court noted that a composition would not appear to be different in any material manner from the composition of appellants' claims no matter to what ultimate use it would be put.

Accordingly, we find that, on the facts of this case, e.g. the completeness of the formulation of the composition contained in the claims, and the mere statement of use in the preamble, that the preambles of claims 1, 13, and 14 are non-limiting. With this determination in mind, we turn to a discussion of the rejections.

III. The Rejections

A) **The Rejection of Claims 1, 3-5 and 9 under 35 U.S.C.**
§103(a) as being unpatentable over Kakade and Oftedal.

The examiner has found that Kakade teaches a milk replacer which comprises protein, fat, carbohydrates, lactose and whey. On a dry matter basis, the examiner has found that the amount of protein can be from 13.3% to 32%; 1.33 -50% oil fat; and 13-90% carbohydrates (by dry matter weight). Lactose can be present from 10-35% of the carbohydrate. The examiner has additionally found that Oftedal teaches protein is present in canine milk in an amount of between 35-45% on a dry matter basis. The examiner thus concludes that it would have been obvious to one of ordinary skill in the art to develop a canine milk with a protein range of 35-45%, as natural milk contains protein levels in that range. Additionally, the examiner concludes that it would have been obvious to optimize the percentages of fat, protein, and carbohydrates (Paper #3, page 2, line 13 - page 4, line 2).

The appellant urges that there is no motivation or reasoning for one to modify the references to meet the claimed limitations, that the references are not directed to compositions which are intended to duplicate canine milk, and that therefore there is no

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prima facie case of obviousness. (Appeal Brief, page 5, lines 6-12).

In order to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2D 1635, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617.

In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein).

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In the present instance, the instant claims broadly claim a canine milk replacing composition having various constituents of fat, protein, and carbohydrate, with a particular protein ratio. The primary references, Oftedal and Kakade, relate to milk and/or milk replacers for animals. Their principal disclosure includes the analysis and/or replacement of natural milk as a source of nutrients. As noted by Kakade, 10-45% carbohydrate is provided in the concentrate, with 10-35% of the concentrate being lactose. (Kakade, column 2, lines 25-30). At least 60% of the 10-16% protein in the concentrate is whey (Id., column 2, lines 36-40). Finally, fat is to be present in an amount of from 1-25% in the concentrate. (Id., column 2, lines 59-61). It is also taught that the food should provide desired growth factors (Id., column 1, lines 34-36).

Oftedal, on the other hand, illustrates that natural canine milk contains about from 39-45% fat, 30-35% protein, and 14-19% carbohydrates.²

We find that these references are closely related to the claimed subject matter, the nutrition of suckling puppies. Thus they are reasonably pertinent and would commend themselves to the

² Calculated from Oftedal's Table 1, page 805.

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attention of one of ordinary skill in the art concerned with feeding suckling puppies. We therefore agree with the examiner that these references are properly combinable. Further, we concur that it would have been obvious to one of ordinary skill in the art to optimize the claimed ranges of fat, protein, and carbohydrate as taught by Oftedal to be provided in nature.

The appellant, however, raises a compelling point. The ratio of casein to whey is nowhere found in either reference, and Kakade in fact teaches that the majority of the proteins should be whey (Appeal Brief, page 8, lines 11-15). The examiner has stated it would have been obvious to optimize to the needs of a young animal to adjust the amount of whey and casein. (Examiner's Answer, page 9, lines 3-9). While this statement may be generally true, there is simply no evidence in the cited references of record before us pertaining to this rejection to support the examiner's position.

The only evidence that different proteins can be used is a contrary teaching of 60% whey. We therefore must reverse the rejection of claim 1 over the applied references, as the examiner has failed to establish that this claimed element would have been obvious in view of the cited references utilized in the rejection of claim 1.

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C) The Rejection of Claims 6 and 14 under 35 U.S.C. §103(a)
as being unpatentable over Oftedal in view of Kakade as applied to
claims 1, 3-5 and 9, and further in view of Gil.

As we have reversed the underlying rejection over Oftedal in
view of Kakade, we reverse this rejection for the same reasons as
noted above.

D) The Rejection of Claims 7 and 11 under 35 U.S.C. §103(a)
as being unpatentable over Kakade, Oftedal, and Gil as applied to
claims 6 and 14, further in view of Traitler.

As we have reversed the underlying rejection over Oftedal in
view of Kakade, we reverse this rejection for the same reasons as
noted above.

E) The Rejection of Claims 8 and 12 under 35 U.S.C. §103(a)
as being unpatentable over Kakade and Oftedal as applied to claims
1, 3-5 and 9, and further in view of Kinumaki.

As we have reversed the underlying rejection over Oftedal in
view of Kakade, we reverse this rejection for the same reasons as
noted above.

F) The Rejection of Claims 10 and 13 under 35 U.S.C. §103(a)
as being unpatentable over Kakade and Oftedal as applied to claims
1, 3-5 and 9, further in view of Fujimori.

As we have reversed the underlying rejection over Oftedal in view of Kakade, we reverse this rejection for the same reasons as noted above.

IV. New Grounds of Rejection

G) **Claims 1, 3-5, 7-9, and 11-12 are rejected under 35 U.S.C. §102(b) as anticipated and alternatively under 35 U.S.C. §103(a) as obvious over the Admitted Prior Art.**

The appellant admits in the specification that naturally occurring beagle milk contains various components, including 40.40% protein, 31.8% Fat, 18.5% carbohydrate, and a casein/whey ratio of 70:30 (Specification, page 5, lines 21-26). The specification also admits that it is "generally accepted that milk from the lactating mother provides optimal nutrition to the suckling puppy. Accordingly, milk replacers currently in use have been formulated with the intent of matching the nutrient composition of bitch milk." (Id., page 1, lines 8-11).

Naturally occurring canine milk contains all of the elements of instant claim 1. As we have found the claim preamble to be non-limiting, we therefore conclude that naturally occurring canine milk³ clearly anticipates the subject matter of claim 1.

³ We take judicial notice of the fact that the beagle has been nursing puppies with naturally produced beagle milk long before the subject matter of the instant application was invented. For completeness sake, in support of this taking notice we note that the Specification, page 5, footnote, refers to and

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In the alternative, given the known desired formulation of milk replacers to closely match the nutrient composition of canine milk, it would have been obvious to one of ordinary skill in the art to formulate a milk replacer with the composition of claim 1 to match the components of the natural beagle milk.

Claims 3-5 are similarly clearly anticipated and/or obvious within the meaning of 35 U.S.C. § 102(b) and/or 103(a) as follows.

Instant claim 3 recites "about 38% protein." Natural beagle milk contains 40.40% protein (specification, page 5, lines 21-26), which clearly anticipates a composition containing "about 38%" protein. In the alternative, it would have been obvious to formulate a canine milk replacer which contains about 38% protein, as it was known to formulate milk replacers to match the content of natural milk.

Instant claim 4 recites "about 28% fat." Natural beagle milk contains 31.8% fat (specification, page 5, lines 21-26), which clearly anticipates a composition containing "about 28%" fat. In the alternative, it would have been obvious to formulate a canine milk replacer which contains about 28% fat, as it was known to formulate milk replacers to match the content of natural milk.

utilizes data from a reference work (Lonnerdal) reciting beagle milk composition, and dated 1981 and Oftedal, dated 1984.

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Instant claim 5 recites "about 19% carbohydrates." Natural beagle milk contains 18.5% carbohydrates (specification, page 5, lines 21-26), which clearly anticipates a composition containing "about 19%" carbohydrates. In the alternative, it would have been obvious to formulate a canine milk replacer which contains about 19% carbohydrates, as it was known to formulate milk replacers to match the content of natural milk.

H. Claims 7, 8, 9, 11, and 12 are rejected under 35 U.S.C. §103(b) as obvious over the Admitted Prior Art.

Instant claim 7 recites 15-19% palmitic acid, about 5-9% stearic acid, about 34-38% oleic acid, about 17-21% linoleic acid, 1-4% alpha-linoleic acid, about 0.5-2% arachidonic acid, about 0.2 to 1% docosahexaenoic acid, about 2 to 5% Omega 3 fatty acids, about 18-22% Omega 6 fatty acids, and from about 1-4% trans fatty acids.

Instant claim 8 recites about 6-10% arginine, 4-8% histidine, 8-12% isoleucine, 16-20% leucine, about 13-17% lysine, about 2-7% methionine, about 6-10% phenylalanine, about 8-12% threonine, about 1-4% tryptophan, about 9-13% valine, about 2-5% cystine, and about 2-6% tyrosine, based on the total weight of amino acids.

Instant claim 9 recites from about 4 to 8% by weight lactose.

Instant claim 11 recites about 27% to 37% by weight fatty acids.

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Instant claim 12 recites from about 15 to 15% by weight essential amino acids.

Although the claimed ranges are not specifically exemplified or analyzed for in the Admitted Prior Art beagle milk, the compositions of the claimed milk replacer and the prior art beagle milk are so close (and stated to be modeled upon natural beagle milk) that they are reasonably expected to behave in the same or similar manner. Compare Titanium Metals Corp. v. Banner, 778 F.2d 775, 783, 227 USPQ 773, 779 (Fed. Cir. 1985).

Where general conditions of the appealed claim are disclosed in the prior art, it is not inventive to discover optimum or workable ranges by routine experimentation, and appellant has the burden of proving any criticality. In re Boesch, 617 F.2d 272, 276, 205 USPQ 215, 218-19 (CCPA 1980); In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). The appellant has not done so with the claimed compositions vis-a-vis natural beagle milk.

I. Claims 6 and 14 are rejected under 35 U.S.C. §103(a) as obvious over the Admitted Prior Art in view of Gil.

Instant claim 6 recites that the source of fat is corn oil, canola oil, butter oil, arachidonic acid, docosahexaenoic acid, and blends thereof.

Instant claim 14 recites that the composition contains about 35-45% protein, about 25-35% fat, and from about 10-25%

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carbohydrates, and the fat source is corn oil, canola oil, butter oil, arachidonic acid, docohexaenoic acid, and blends thereof.

The admitted prior art is as discussed above. Gil teaches a preferred source of fat for a human milk replacer includes an oil such as corn oil (column 10, line 64). Gil also experimentally teaches feeding weanling rats (column 24, line 59 et seq.) from its example 13. Example 13 and example 4a contain the same fat mixtures, and example 4a is said to contain arachidonic and docosahexaenoic acid, with beneficial effect on the rats. (column 17, lines 40-58).

Consequently, it would have been obvious to utilize corn oil, arachidonic acid, or docohexaenoci acid as a fat source in the instantly claimed canine milk replacer of claims 6 and 14 to obtain the beneficial effects found in humans and rats.

J. Claims 10 and 13 are rejected under 35 U.S.C. §103(a) as obvious over the Admitted Prior Art with or without Fujimori.

Claim 10 recites that the composition contains about 0.50% by weight fructooligosaccharide.

Claim 13 recites that the composition contains about 35-45% protein, about 25-35% fat, and from about 10-25% carbohydrates, further containing about 4-8% by weight lactose and 0.5% by weight fructooligosaccharide (FOS).

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The Admitted Prior Art is as discussed above. The Admitted Prior Art (specification, page 7, lines 16-22) further states that 0.50% FOS is known to improve the intestinal health of "many animals". Accordingly, it would have been obvious to incorporate the FOS into the claimed composition.

Alternatively, Fujimori teaches that fructooligosaccharides known to be in pet foods to reduce objectionable odors in pet wastes. (See, e.g. Fujimori, column 2, lines 45 et seq.). The lactosucrose is utilized in an amount of 0.25 parts by weight (column 6, lines 25-26). Accordingly, it would have been obvious to use the fructooligosaccharide in the canine milk replacer to obtain the known benefits.

V. Additional Issues

If further prosecution is undertaken, the examiner and appellant should obtain a complete translation of the Meyer reference. We note that the Search Report from the EPO designates Meyer an "X" reference. We have reviewed the record and observe that Meyer was submitted and reviewed as an English language abstract only. Although the examiner appears to have initialed the PTO 1449 (Paper #6) supplied by the appellant, in the absence of a German language translation, we do not see how it is possible for such review to have occurred.

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It appears that at least instant claims 1, 3, 4, 5, and 9 should be rejected under 35 U.S.C. §103(a) as being unpatentable over Meyer. Meyer recites in its disclosed claim 1 (taken from the translated, published claims which were not previously provided to the PTO) a canine milk substitute which includes (by weight) a protein content of more than 30%, a fat content of more than 25%, and a lactose (a carbohydrate) content of less than 30% (Meyer, page 6, lines 29-36).

The protein is divided between albumin and globulin (components of whey) and casein at a ratio of 2.1 to 3.0:4.1 to 5.0. (Id., page 6, line 36). At its range endpoint (casein:whey 5.0:2.1) the ratio is equal to about 70:30. We observe that each of these disclosed limitations in the claim of Meyer overlaps the claimed ranges of claim 1.

A prima facie case of obviousness typically exists when the ranges of a claimed composition overlap the ranges disclosed in the prior art. See, e.g., In re Geisler, 116 F.3d 1465, 1469, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997); In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (CCPA 1976); In re Malagari, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974). In cases involving overlapping ranges, our reviewing court and its predecessor have consistently held that even a slight overlap in range establishes a prima facie case of obviousness. Woodruff,

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919 F.2d at 1578, 16 USPQ2d at 1936-37 (concluding that a claimed invention was rendered obvious by a prior art reference whose disclosed range ("about 1-5%" carbon monoxide) abutted the claimed range ("more than 5% to about 25%" carbon monoxide)).

Claim 3 recites that the protein content is "about 38%." Meyer's claimed range discloses a protein content of more than 30%, which encompasses the instantly claimed range of about 38%.

Claim 4 recites that the fat content is "about 28%." Meyer's claimed range is more than 25%, which encompasses the instantly claimed range of about 28%.

Claim 5 recites that the carbohydrate content is "about 19%." Meyer's claimed range of lactose (a carbohydrate) is less than 30%, which encompasses the instantly claimed range of about 19%.

Claim 9 recites that the composition contains from "about 4 to 8% by weight lactose." Meyers disclosed claimed range of lactose is less than 30%, which encompasses the instantly claimed range of about 4 to 8%.

Thus, it appears that Meyer may render the above-discussed claims obvious. Accordingly, in the event of further prosecution, a complete translation of Meyer should be obtained and considered against all of the claims of this application.

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Summary of Decision

The rejection of Claims 1, 3-5 and 9 under 35 U.S.C. §103(a) as being unpatentable over Kakade and Oftedal is reversed.

The rejection of claims 6 and 14 under 35 U.S.C. §103(a) as being unpatentable over Oftedal in view of Kakade as applied to claims 1, 3-5 and 9, and further in view of Gil, is reversed.

The rejection of claims 7 and 11 under 35 U.S.C. §103(a) as being unpatentable over Kakade, Oftedal, and Gil as applied to claims 6 and 14, further in view of Traitler is reversed.

The rejection of claims 8 and 12 under 35 U.S.C. §103(a) as being unpatentable over Kakade and Oftedal as applied to claim 1, 3-5 and 9, and further in view of Kinumaki is reversed.

The rejection of claims 10 and 13 under 35 U.S.C. §103(a) as being unpatentable over Kakade and Oftedal as applied to claim 1, 3-5 and 9, further in view of Fujimori, is reversed.

The following new grounds of rejection are made:

Claims 1, 3-5, 7-9, and 11-12 are rejected under 35 U.S.C. §102(b) as anticipated and alternatively under 35 U.S.C. §103(a) as obvious over the Admitted Prior Art.

Claims 7, 8, 9, 11, and 12 are rejected under 35 U.S.C. §103(b) as obvious over the Admitted Prior Art.

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Claims 6 and 14 are rejected under 35 U.S.C. §103(a) as obvious over the Admitted Prior Art in view of Gil.

Claims 10 and 13 are rejected under 35 U.S.C. §103(a) as obvious over the Admitted Prior Art with or without Fujimori.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner.

. . .
(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED; 1.196(b)


BRADLEY R. GARRIS
Administrative Patent Judge


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